



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Bradfo

Bradford Giles Ackerman, et al.

Serial No:

09/844.947

Examiner: John Hoffman Group Art Unit: 1731

Filing Date: April 27, 2001

Title:

METHOD FOR PRODUCING

TITANIA-DOPED FUSED

SILICA GLASS

Mail Stop: Appeal Brief-Patents Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir

BRIEF ON APPEAL COVER LETTER

Enclosed is Appellants Brief on Appeal of the Notice of Appeal that was filed on August 31, 2007.

Please chare the necessary fees of \$500.00 for filling the Brief on Appeal to our Deposit Account No. 03-3325. If there are any other fees due in connection with the filling of this Brief on Appeal, for example an extension of time to make this brief timely, please charge the fee(s) to our Deposit Account No. 03-3325.

Respectfully submitted,

Dated: Octobe 31, 2007

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8: I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, No. EM087163937US, in an envelope addressed to Mail Stop Appeal Brief – Patents,

July Hen Shaw

Bv:

Waller M. Douglas

Registration No. 34,510 607-974-2431 Corning Incorporated Patent Department

SP-TI-03-01 Corning, NY 14831 APPEAL BRIEF PATENT

October 31, 2007 Attorney Docket No.: SP01-095

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

entor: Bradford Giles Ackerman, et al.

Serial No: 09/844.947 Examiner: John Hoffman

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Title: METHOD FOR PRODUCING

TITANIA-DOPED FUSED SILICA GLASS

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Sir:

BRIEF ON APPEAL

This Brief supports the appeal to the Board of Patent Appeals and Interferences from the Final Rejection dated March 12, 2007, in the above application listed above, and the Advisory Action mailed August 9, 2007, maintaining all rejections. Appellants mailed, by First Class Mail, a Notice of Appeal on August 31, 2007 in accordance with 37 C.F.R. § 41.31. A Return Postcard bearing the Patent Office stamped date of September 4, 2007 was received. On October 17, 2007 Appellants received a Notice of Abandonment mailed October 11, 2007. On October 18, 2007 Appellants mailed, by Express Mail, a Petition for Revival of the present application on the grounds of a Patent Office error. The Petition included documentation, specifically the Patent Office stamped postcard, indicating that an Appeal was timely filed. As of the date of the

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mailing of this Brief on Appeal appellants have not heard from the Patent Office

regarding whether or not the Petition for Revival has been granted.

Accordingly, Appellants believe that the date for timely filing of their Brief on

Appeal is October 31, 2007 based on Appellants Notice of Appeal filing date of August

31, 2007. Thus, Appellants submit this Brief is in accordance with 37 C.F.R. § 41.37.

I. REAL PARTY IN INTEREST

The real party in interest in this Appeal is Corning Incorporated, assignee of the

entire interest in this application by virtue of an assignment recorded 08/21/2001 at

Reel/Frame 012100/0096.

II. RELATED APPEALS AND INTERFERENCES

With respect to the appeals or interferences that will directly affect, or be

directly affected by, or have a bearing on the Board's decision in this appeal, there are

no such appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-2, 4-9, 13, 15, 20, 21, and 23-24 are pending in the application.

Claims 1-2, 4-9, 13, 15, 20, 21, and 24 are under appeal.

Claim 23 is withdrawn from appeal and hereby cancelled.

Claims 3, 10-12, 12, and 23 were perviously cancelled.

Claims 16-19 were withdrawn from consideration due to a restriction

requirement.

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The present application was filed on April 27, 2001 with claims 1-19. An Office Action with a Restriction Requirement was mailed September 15, 2003, and in their Response applicants (now the Appellants) withdrew from consideration claims 16-19 with reservation of right to file a divisional application, cancelled claims 3, 10-12 and 14, and added new claims 20-23. A Final Office Action was mailed February 13, 2004 and applicants replied on April 13, 2004. Applicants received an Advisory Action mailed April 29, 2004 advising that the Final rejection would be maintained and the amendment would not be entered because it raised new issues.

Applicants filed a Request for Continued Examination on May 13, 2004 and received an Office Action mailed May 29, 2004. Applicants replied on September 21, 2004 and received a Final Office Action mailed January 21, 2005. Applicants filed a response on March 11, 2005 and received an Advisory Action mailed March 29, 2005 indicating that the Final Rejection of the claims would be maintained and that the amendments submitted in applicants' Response would not be entered because they raised new issues that would require further consideration and/or search. Applicants filed their First Notice of Appeal on April 11, 2005. On June 3, 2005 applicants timely filed a Brief on Appeal. Between June 3, 2005 and April 12, 2006 the Brief on Appeal was revised four times pursuant to a Notice from the Patent Office and filed the new Brief(s), the last filing being April 12, 2006.

Applicants received an Office Action mailed June 6, 2006 indicating that in view of their Appeal Brief of April 12, 2006, <u>prosecution was reopened</u> and new grounds for rejection were given. Applicants replied on October 25, 2006, received a Notice of Non-compliant Amendment mailed December 14, 2006 and replied to the

Notice on December 21, 2006. Applicants received a Final Rejection mailed March 12, 2007 and replied to the Rejection on May 23, 2007. Applicants received an Advisory Action mailed August 9, 2007. Applicants replied to the Advisory Action by mailing a Notice of Appeal (with a request for an extension of time) with a Return Postcard on August 31, 2007. The Postcard was returned indicating that the Notice of Appeal and

other papers were received by the Patent Office on September 4, 2007.

On October 17, 2007 applicants received a Notice of Abandonment mailed

October 11, 2007. On October 18 2007 applicants filed a Petition For Revival Of An

Unavoidable Abandoned Patent Application, indicating their belief that the

abandonment was due to a Patent Office Error. A copy of the Return Postcard bearing
the Patent Office stamp was enclosed as proof that the Appeal was time made. At the
present time applicants, now Appellants, have not received a reply from the Patent

Office regarding their Petition for Revival.

Appellants now submit this Brief on Appeal in order to be timely in with regard to its submission and further in the belief that their Petition for Revival will be granted.

In view of the fact that applicant last amendment of May 23, 2007 was not entered by the Examiner, the claims under appeal are those that were present in the application prior to May 23, 2007.

A copy of the claims under appeal is attached in the appendix.

IV. STATUS OF AMENDMENTS

Appellants Amendment after Final Rejection was filed on May 23, 2007 and has not been entered. Thus, for purposes of this Appeal the Amendment filed May 23,

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2007 should be considered as not having been made due to the Examiner's rejection of the Amendment and statement that further prosecution would require an additional search. The claims presented herein are those that existed at the time the Final Office Action was issued

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is the only independent claims. Claims 2, 4-9, 13, 15, 20, 21, and 23-24 depend on claim 1 either directly or indirectly through another dependent claim. The claimed invention relates to a method for producing a fused silica glass containing titania (a SiO₂-TiO₂ glass).

Claim 1 is directed to a method for producing a fused silica glass containing titania [page 2, lines 17-18] by synthesizing particles of silica and titania by delivering a mixture of a silica precursor and a titania precursor to a burner [page 2, lines 18-19; page 3, lines 3-5; page 4, lines 4-14; and page 5, lines 1-3]; growing a column of a porous preform [page 3, lines 19-21 and page 5, lines 1-13 and particularly lines 5-6 in combination with Figures 1 and 2, numeral 40 showing the column growing] by successively depositing the particles on a deposition surface [page 2, lines 19-21; page 3, lines 5-6; and page 4, lines 15-24; (a *deposition surface is also called a "bait" by those skilled in the art*)] at a temperature below the minimum temperature at which the particles can consolidate into a glass [page 3, lines 8-10 and original claim 3] while successively translating the deposition surface away from the burner [page 3, lines 19-22; page 3, lines 19-24; and page 5, lines 6-81; and subsequently

consolidating the porous preform into dense glass [page 2, line 21-22; page 3, lines 5-6; and page 5, lines 14-19].

Claim 2 depends on and further limits claim 1. Claim 2 states that the translation speed of the deposition surface is adjusted to maintain a substantially constant distance between an end portion of the porous preform remote from the deposition surface {a.k.a. "bait"} and the burner during deposition [page 4, lines 21-26 for all].

Claim 4 depends on and further limits claim 1. Claim 4 states that the consolidation of the porous preform is carried out at a temperature in the range of 1200 to 1900 °C [page 5, lines 16-19].

Claim 5 depends on and further limits claim 1. Claim 5 states that the porous preform can be dehydrated by exposing the porous preform to a heated, halide-containing atmosphere prior to consolidation [page 3, lines 10-13 and lines 21-22; and page 5 lines 15-26].

Claim 6 depends on and further limits claim 5. Claim 6 states that the halide-containing atmosphere comprises chlorine [page 5, lines 14-24].

Claim 7 depends on and further limits claim 5. Claim 6 states that the halide-containing atmosphere comprises fluorine [page 5, line. 24-26].

Claim 8 depends on and further limits claim 5. Claim 8 states that the temperature of the heated, halide-containing atmosphere is in the range of from 900 to 1100 °C [page 5, lines 21-22].

Claim 9 depends on and further limits claim 1. Claim 9 states that the glass contains 2 to 12% by weight titania [page 5, lines 27-28].

Claim 13 depends on and further limits claim 5. Claim 13 states that the translation speed of the deposition surface is adjusted to maintain a substantially constant distance between an end portion of the porous preform remote from the deposition surface {a.k.a. "bait"} and the burner during deposition [page 4, lines 21-26 for all].

Claim 15 depends on and further limits claim 5. Claim 15 states that the consolidation of the porous preform is carried out at a temperature in the range of 1200 to 1900 °C [page 5, lines 16-19].

Claim 20 depends on and further limits claim 1. Claim 20 states that the minimum [consolidation] temperature is 1200 °C [page 5, lines 16-18 which indicates that the minimum temperature for consolidation is 1200 °C].

Claim 21 depends on and further limits claim 20 [page 3, lines 8-10 in combination with page 1, line 28, to page 2 line 2, which indicate that conventional boule consolidation temperatures are 1200 to 1900 °C1.

Claim 23 is withdrawn from appeal and cancelled.

Claim 24 depends on and further limits claim 1. Claim 24 states that the deposition surface is rotated relative to the burner which successively depositing the particles on the deposition surface [page 2, lines 21; page 3, line 19; and 4, lines 19-23]

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-2, 4-9, 13, 15, 20, 21, and [23]-24 stand rejected under 35 U.S.C. §112, first paragraph.

The Examiner has stated that claims 1-2, 4-9, 13, 15, 20, 21, and [23]-24 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. That is, the claims contain subject matter which was not described in the specification in such a way as to reasonable convey to one skilled in relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The Examiner states:

1st s Statement (Final Office Action, page 2, lines 8-12)

"Examiner could find no support for the claimed "column of solid porous perform", or "solid porous", "successively translating", "a deposition surface at a temperature below the minimum temperature at which the particles can consolidate" - either explicit or implicit. This is deemed to be a *prima facie* showing of failure to comply with the requirement." [Office Action of 03/12/07, page 2, approximately lines 13-18.]

The Examiner further states:

2nd Statement

"Moreover, it is clear that at least the temperature limitation and "while successively translating" cannot be implicitly supported because they are impossible. The terms "while" and "successively" are two mutually exclusive conditions: 'while' means simultaneously, and "successively" means following each other. Nor can a translation be successive with itself - at best it would have to be successive with some other translation. But there is no support for two successive translations (that the Examiner can find) - Applicant cannot now claim two successive translations when the specification does not provide support therefor. As to the temperature limitation, the particles could not stick to the support or to each other if the temperature is as low as claimed. In other words, Applicant is correct in arguing that Blackwell does not meet the temperature limitation - but for the same reason. Applicants' invention does not provide support therefor." [Office Action of 03/12/07, page 2, approximately line 19 to page 3, line 7.]

The Examiner additionally states:

3rd Statement

"Either something is solid or it is porous, it cannot be "solid porous - or if it could possibly be, there would have to be support for such in the specification. The only mention of "solid" in the specification that the Examiner could find if in reference to dense, solid glass." [Office Action of 03/12/07, page 3, lines 8-11.]

The Examiner further states:

4th Statement

"There is no support for claims 20-21. Applicant does not dispute this, thus it deemed that applicant acquiesces on this point."

B. Claims 1-2, 4-9, 13, 15, 20, 21, and 23-24 stand rejected under 35 U.S.C.

§112, second paragraph, as being indefinite for failing to particularly
point out and distinctly claims the subject matter which applicants
regard as the invention.

The Examiner states:

5th Statement

In his fifth statement the Examiner stated that "Applicants has not disputed this rejection, thus it deemed that applicant acquiesces that the claims fail to particularly point out and distinctly claim the subject matter."

6th Statement

"Claim 1: it is not understood that is meant by "column of solid porous preform" - is unclear if it means "column of solid glass or a porous preform", or "a porous column of solid preforms" or something else. As alluded to above, the term "solid porous" is indefinite as to its meaning. And, it is unclear what is meant bye "while successively" - since these two words connote mutually exclusive conditions (see above)."

7th Statement

"Claim 5: it is unclear if the 'consolidation' refers to the consolidating step or claim 1, or if it is open to any consolidation."

8th Statement

"Claim 21: There is noted that there is no antecedent basis for "the temperature at which the particles are deposited" = it is unclear if the claim is directed to the actual deposition temperature, or if it is directed to the temperature of the deposition surface."

C. Art Rejections: 35 U.S.C. § 102 or 103

NONE

VII. ARGUMENTS

For the convenience Board of Patent Appeals and Interferences (the "Board") convenience, a copy of the (1) Final Office of March 12, 2007, Appellants' Response of May 23, 200, and Appellants Response of December 2, 2006 are attached in the Evidence Appendix. These attachments are necessary for a complete showing that Appellants have fully replied to all rejections and that the Examiner's statements in the Final Office Action the Appellants did not response to certain items is incorrect.

A. 35 U.S.C. §112, first paragraph rejections - Appellants Response.

In support of the arguments made herein, Appellants' have included <u>complete</u>

<u>copy</u> of their Response of May 23, 2007 in the Evidence Appendix.

In Moba B.V. v. Diamond Automation Inc., 66 USPQ2d 1419, 1437 (Fed. Cir. 2003) the Court of Appealas for the Federal Circuit reiteated that a "patent specification must contain an adequate written description. 35 U.S.C. §112, ¶1 (1994. The court further stated that "The written description requirment does not require the applicant 'to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed'" Id at 1439 (brackets in the text, citation omitted in text). The court went on to say, in reference to Enzo [Enzo Biochem, Inc v. GenProbe, Inc, 63 USPQ2d 1609 (Fed. Cir. 2002)] and and Amgen [Amgen, Inc. v. Hoechst Marion Roussel, Inc., 65 USPQ2d 1385, 1387 (Fed. Cir. 2003)], that "the record showed that the specification

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that taught one of skill in the art to make and use the invention also convinced the

artisan that the inventor possessed the invention." In the present case, Appellants'

specification, read together with the figures, teaches one of skill in the art the claimed

method of aking titania-doped silica glass as will be shown by citations below to the

specification and figures.

The court further stated that The court further stated that "the patent specification must

disclose information sufficient to enable those skilled in the art to make and use the

claimed invention. Id at 1439. In addition the court

Examiner's 1st Statement

Appellants submit that the Examiner is mistaken in his conclusions and that all

the terms in the Examiner's 1st Statement are supported by the specification and would

be understood by one skilled in the art. Further, Appellants assert that it is well

understood that the claims must be read in light of the specification and the figures that

may accompany it. In the present case the specification is accompanied by two (2)

drawings.

Claim 1 states that the a column of a solid porous preform is grown by

successively depositing the particles on a deposition surface at a temperature below a

minimum temperature at which the particles can consolidate either partially or fully

into dense glass while successively translating the deposition surface away from the

burner.

Appellants now refer to the specification on page 4, lines 15-24, and Figures 1

and 2 which describe and illustrate the formation of the solid porous preform 40 by the

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deposition of the soot from burners 28 on the deposition surface ("bait") 34 which is attached by a pin 35 to a spindle 36 that can be ascended (i.e., "translated") upward [see the arrow on the spindle in the Figures] by means of the motor drive 38. The specification on page 5, lines 5-6 states: "The soot is deposited on the lower end of bait 34 to form a columnar porous preform."

One skilled in the art, after reading the foregoing sections of the specification and viewing the Figures would clearly understand that using the process steps as described one:

- · can continuously grow the preform 40, and
- that the preform is a porous solid as stated by applicants,
- that the preform is in the form of a column (columnar), and
- that the columnar solid porous preform is formed as a result of the upward translation of the bait during the deposition of the soot.

One skilled in the art would also understand that the solid columnar preform is also porous because the chlorine treatment step described on page 5, lines 14-16 requires that the preform be porous in order for the chlorine to penetrate the preform to form and remove volatile metal chlorides and also to remove OH from the glass structure.

Regarding the temperature at which the deposition is carried out, Claim 1 states the particles are deposited on a deposition surface (e.g., the "bait") at a temperature below a minimum temperature at which the particles can consolidate either partially or fully into dense glass while successively translating the deposition surface away from the burner.

The Detailed Discussion (page 5, lines 16-19) indicates that consolidation temperatures are typically in the range of 1200-1900 °C, with a preferred range being 1300-1700 °C. The specification indicates on page 3, lines 8-10, states that consolidating the glass in a separate step eliminates the need to capture the soot at consolidation temperatures and permits the soot to be captured at a lower temperature, typically 200-500 °C lower, than possible with the conventional boule process [a process in which the soot is captured at consolidation temperatures; see page 5, lines 16-19 for preform consolidation temperatures]. Using the foregoing information, one skilled in the art would understand that applying the "200-500 °C lower temperatures" to the 1200-1900 °C range results in a "minimum temperature of 1000 °C and applying the 200-500 °C lower temperatures to the preferred 1300-1700 °C range results in a minimum temperature of 1100 °C. Further, one skilled in the art reading the "chlorine treatment" temperature range of 900 - 1100 °C would further understand that the "minimum temperature" can correspond to this range because chlorine purification requires that the gas penetrate the preform and that this is done prior to consolidation.

Consequently, Appellants submit that the specification is fully supports the terms the Examiner complained of in his 1st Statement and that the specification fully supports these terms as used in claim 1 and claims 2, 4-9, 13, 15, 20, 21, and 24.

Examiner's 2nd statement

The Examiner states the at least the "temperature limitation" and "while successively translating" cannot be implicitly supported - because they are impossible.

First, regarding the temperature limitation, In their comments above concerning the Examiner's 1st Statement, Appellants, *citing page and line*, have shown that the temperature limitation (that is, the "minimum temperature") is fully supported by the specification and have also shown how one skilled in the art would understand and be able to practice the invention. Those comments, given above, are:

"The background art (page 2, line 1) and the Detailed Discussion (page 5, lines 16-19) both indicate that consolidation temperatures are typically in the range of 1200-1900 °C, with a preferred range being 1300-1700 °C. The specification indicates on page 3, lines 8-10, states that consolidating the glass in a separate step eliminates the need to capture the soot at consolidation temperatures and permits the soot to be captured at a lower temperature, typically 200-500 °C lower, than possible with the conventional boule process [a process in which the soot is captured at consolidation temperatures; see page 5, lines 16-19 for preform consolidation temperatures]. Using the foregoing information, one skilled in the art would understand that applying the "200-500 °C lower temperatures" to the 1200-1900 °C range results in a "minimum temperature of 1000 °C and applying the 200-500 °C lower temperatures to the preferred

1300-1700 °C range results in a minimum temperature of 1100 °C. Further, one skilled in the art reading the "chlorine treatment" temperature range of 900 - 1100 °C would further understand that the "minimum temperature" can correspond to this range because chlorine purification requires that the gas penetrate the preform and that this is done prior to consolidation."

Second, regarding the phrase "while successively translating," this rejection is incorrect because the phrase was taken out of contextby the Examiner. The only translation described is the specification is the upward translation of the bait and the "growing columnar solid porous preform" as it is grown on the bait {page 4, lines 15-24, and particularly lines 23-24}.

The relevant part of claim 1 reads as follows:

"... growing a column of solid porous preform by successively depositing the particles on a deposition surface at a temperature below a minimum temperature at which the particles can consolidate into dense glass

while successively translating the deposition surface away from the burner . . . "

Properly read the above clauses indicate that two events are occurring. The <u>first event</u> is that the soot particles are being deposited on the deposition surface (the "bait") to make the preform. The <u>second event</u> is that as the preform is being made the bait is

being moved away from the burner. It is a result of these two events is that one forms the columnar solid porous perform. The specification at page 4, lines 25-26 clearly indicates that the "Burner placement is fixed and the bait speed is adjusted to maintain constant burner-to-preform distance during deposition" [of the soot]. The specification on page 4, lines 23-24 also indicate that the "speed at which the bait ascends is critical to the temperature profile and shape of the porous preform 40 formed on the bait 34."

Appellants submit that the foregoing sections of the specification, viewed also in the light of the Figures, clearly indicate that the solid porous columnar preform is formed in a continuous manner while the bait [on which the preform is being made] is being slowly translated upward.

Third, the Examiner has also made comments concerning "two successive translations". There is only a single translation described in the process. The Examiner's comments can only be due a mistake due to an improper reading of the claim.

Appellants submit that the Examiner is mistaken in his assumption in view of what the specification actually recites.

Fourth, the Examiner has baldly stated that "... the particles <u>could not</u> [emphasis added] stick together if the temperature is as low as claimed." The Examiner mentions Blackwell (U.S. Patent No 5,152,819) as not meeting Appellants' temperature limitation for the same reason. However, the fact that Blackwell does not mention what applicants teach and have done is not a reason for rejection; rather it is an inventive step in an inventive method of making a solid porous columnar preform. In this instance the Examiner is portraying himself as 'one skilled in the art". These is no support for the

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Examiner's statement in Blackwell or any other art the Examiner has cited during prosecution. The fact is that using the method of the invention and the apparatus as illustrated in Figures 1 and 2, the particles to 'stick together" to form a columnar solid porous preform as described.

In contrast to Blackwell et al., Appellants state in claim 1, lines 5-7, that the particles (soot) formed are deposited on "... a deposition surface at a temperature below a minimum temperature at which the particles can consolidate either partially or fully into dense glass..." Thus, Appellants specifically teach that the preform is formed at a temperature below that at which consolidation of the deposited particles [soot] into a glass can occur. Appellants are not required to supply a theory or hypothesis as to why in their method the soot "sticks together" and forms a solid porous preform.

Therefore, Appellants submit that the Examiner is mistaken in his assumption in view of what the specification actually recites and that this ejection should properly be reversed.

Examiner's 3rd Statement

In his 3rd Statement the Examiner say that "Either something is solid or it is porous, it cannot be "solid porous - or it could possibly be there have to be support for such in the specification"

Reading the specification in consideration of the figures, Appellants submit that there is full support for their method forming a "solid porous preform." The specification at page 5, lines 5-6 states that "the soot is deposited on the lower end of

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bait 34 to form a columnar porous preform. One skilled in the art, reading the

specification in view of the Figures, would clearly understand that the invention

describes the formation of a "solid porous article", in this case the silica-titania soot

perform.

The phrase "solid porous" is not contradictory. There are articles which can be

described as "solid porous" which are known not only to those within technical fields,

but also to the general public. For example, sponges, molecular sieves, diesel filter

traps, and activated carbon used to remove hazardous gases and also trap fuel fumes in

vehicles and/or at refuelling stations. Appellants submit that the Examine is in error

regarding his statement that something cannot be both porous and solid. His statement

contrary to experience.

Examiner's 4th Statement

The Examiner has stated: "There is no support for claims 20-21. Applicants

does not dispute this, thus it is deemed that applicant acquiesces on this point."

The Examiner is correct, but only in so far as the rejection of claims 20-21 was

not in Appellants' Response dated October 25, 2006 in response to the Office Action of

June 6, 2006. By mistake this rejection was not answered in the October 25, 2006

Response.

However, when the 4th Statement was made in the Office Action of March 12.

2007, Appellants did reply in their Response of May 23, 2007 on page 8. Appellants

there stated:

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"The Examiner also states that applicant has acquiesced that there

is no support for claims 20 and 21. Applicants traverses. Claims 20

and 21 are as follows.

"20. (previously presented) The method of claim 1, wherein

the minimum temperature is approximately 1200°C.

"21. (previously presented) The method of claim 20, wherein the

temperature at which the particles are deposited is approximately

200 to 500°C less than the minimum temperature.

"Regarding claim 20, applicants refer the Examiner to the

Specification on page 5, lines 16-18, in which applicants indicate

that consolidation temperatures are "typically in the range of 1200

to 1900 °C." The lower temperature is 1200 °C. Those skilled in

the art would understand that 1200 °C would be the minimum

consolidation temperature. Applicants also refer the Examiner to

page 3, lines 5-7 which indicate (1) that performing consolidation in

a separate step allow eliminates the need to capture soot at

consolidation temperatures and (2) that this allows the soot to be

deposited at lower temperatures, typically 200 to 500 °C lower than

in conventional boule processes. Applicants submit that the

specification supports both claims 20 and 21 and that one skilled in

the art would understand this and would understand exactly what

these claims mean."

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While the Examiner did not enter the 'Amendment' because he deemed that it raised

new issues and introduced new matter [into the claims], Appellants did respond to the

rejection.

However, since this rejection is currently pending, Appellants submit that the

above response properly replies to the rejection of amendments to the claims and

Specification. It should be noted that the language inserted into the specification at

page 3, line 11, was the following sentence taken from the original claim 14.

The inserted sentence was:

"That is, the silica and titania particles are deposited at a

temperature below that required to consolidate the porous preform

into dense glass."

Original claim 14 stated:

"The method of claim 10, wherein the silica and titania

particles are deposited at a temperature below that required to

consolidate the porous preform into dense glass."

Since this language was originally present in the application, Appellants believe that

there is no "new matter" issue and that insertion into the cited paragraph is permissible

since the language appear in the specification and claims as-filed.

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B. 35 U.S.C. §112, second paragraph rejections - Appellants' Response

In Verve LLC v. Crane Cams Inc., 65 USPQ2d 1051 (Fed. Cir. 2002), the Court of Appeals for the Federal Circuit reversed a district court finding that the expression "substantially constant wall thickness" in the claims is not supported by the specification and prosecution history by a substantially clear definition of "substantially". Id at 1053. This is similar to what the Examiner in the present case has indicated to Appellants with regard to "solid porous preform", "columnar solid porous preform", "while successively" and other hrases Appellants has used.

In its decision the court overturned the district court, stating:

"We conclude that the court erred in law, in requiring that intrinsic evodence of the specification and prosecution history is the sole source of meaning of words that are used on a technologic contect. While reference to intrinsic evidence is primary in intepreting claims, the criterion is the meaning of words as they would be understood by persons in the field of the invention. Patent documents are written for persons familiar with the relevant field; the patentee is not required to include in the specification information readily understood by practioners, lest every patent be required to be written as a comprehensive tutorial and treatise for the generalist, instead of a concise statement for persons in the field." Id at 1053-1054.

In the present case, Appellants' specification, read together with the figures, would clearly be understood by one skilled in the art of the field of the invention. For example, such skilled persons would be familiar with the formation of preforms and know that soot from burners, can form a solid porous stucture. Such skilled person reading Appellants' specification to together with the figures would know how to practice the claimed method of making titania-doped silica glass.

Examiner's 5th Statement

In his fifth statement the Examiner stated that "Applicants has not disputed this rejection, thus it deemed that applicant acquiesces that the claims fail to particularly point out and distinctly claim the subject matter."

The Examiner is correct only in so far specific mention was not made to the §112, second paragraph rejections in the Office Action Response of October 25, 2006, However, in their Response of May 23, 2007, in which Appellants sought to amend claims and the specification, Appellants sought to correct the alleged defect.

Appellants believe that had the amendments of their response of May 23, 2007 been entered, any defects that may have been present would have been corrected. In their May 23, 2007 response on page on page 9, Appellants specifically stated:

"... the rejections given under 35 U.S.C. §112, second paragraph, are moot in view of the amendments to the specification, for clarity, and the arguments given above which are incorporated herein in their entirety." [Empnasis added].

The specific rejection under §112, second paragraph, are the same as those given under §112, first paragraph and Appellants believed that the same arguments they made in regard to the §112, first paragraph, rejections. Thus, Appellants did present a "good faith" argument, which of course was not entered. The specific §112, second paragraph, rejections were directed to claims 1, 5 and 21 and are dealt with in Appellant's response below regarding the **Examiner's 6th**, 7th and 8th Statements.

Examiner's 6th Statement

The Examiner's 6th Statement states:

"Claim 1: it is not understood that is meant by "column of solid porous preform" - is unclear if it means "column of solid glass or a porous preform", or "a porous column of solid preforms" or something else. As alluded to above, the term "solid porous" is indefinite as to its meaning. And, it is unclear what is meant bye "while successively" - since these two words connote mutually exclusive conditions (see above)."

This rejection is the same as that made in the Examiner's 1st and 2nd Statement as indicated above, though in combined form in this instance.

Claim 1 states that the a column of a solid porous preform is grown by successively depositing the particles on a deposition surface at a temperature below a minimum temperature at which the particles can consolidate either partially or fully into dense glass while successively translating the deposition surface away from the burner.

First, Appellants now refer to the specification on page 4, lines 15-24, and Figures 1 and 2 which describe and illustrate the formation of the solid porous preform 40 by the deposition of the soot from burners 28 on the deposition surface ("bait") 34 which is attached by a pin 35 to a spindle 36 that can be ascended (i.e., "translated") upward [see the arrow on the spindle in the Figures] by means of the motor drive 38. The specification on page 5, lines 5-6 states: "The soot is deposited on the lower end of bait 34 to form a columnar porous preform."

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One skilled in the art, after reading the foregoing sections of the specification and viewing the Figures would clearly understand that using the process steps as described one:

- can continuously grow the preform 40, and
- that the preform is a porous solid as stated by applicants,
- that the preform is in the form of a column (columnar), and
- that the columnar solid porous preform is formed as a result of the upward translation of the bait during the deposition of the soot.

One skilled in the art would also understand that the solid columnar preform is also porous because the chlorine treatment step described on page 5, lines 14-16 requires that the preform be porous in order for the chlorine to penetrate the preform to form

Second, regarding the phrase "while successively" (or "while successively translating") this rejection is incorrect because it taken out of context. The only translation described is the specification is the upward translation of the bait and the "growing columnar solid porous preform" as it is grown on the bait {page 4, lines 15-24, and particularly lines 23-24}.

The relevant part of claim 1 reads as follows:

"... growing a column of solid porous preform by successively depositing the particles on a deposition surface at a temperature below a minimum temperature at which the particles can consolidate into dense glass

while successively translating the deposition surface away from the burner . . . "

Application No. 09/844,947

Properly read the above clause indicates that two events are occurring. The first event

is that the soot particles are being deposited on the deposition surface (the "bait") to

make the preform. The second event is that as the preform is being made the bait is

being moved away from the burner. As the preformform on the bait and the bait

ascends away from the burners [page 4, lines 23-24 and Figures 1 and 2] the deposition

surface becomes the that part of the preform that has been deposited on the bait. It is a

result of these two events is that one forms the columnar solid porous perform. The

specification at page 4, lines 25-26 clearly indicates that the "Burner placement is fixed

and the bait speed is adjusted to maintain constant burner-to-preform distance during

deposition" [of the soot]. The specification on page 4, lines 23-24 also indicate that

the "speed at which the bait ascends is critical to the temperature profile and shape of

the porous preform 40 formed on the bait 34."

Appellants submit that the foregoing sections of the specification, viewed also

in the light of the Figures, clearly indicate that the solid porous columnar preform is

formed in a continuous manner while the bait [on which the preform is being made] is

being slowly translated upward.

Examiner's 7th Statement

The Examiner's 7th Statement states:

"Claim 5: it is unclear if the 'consolidation" refers to the

consolidating step of claim 1, or if it is open to any consolidation."

Claim 5 states:

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5. The method of claim 1, further comprising dehydrating the

porous preform by exposing the porous preform to a heated,

halide-containing atmosphere prior to consolidation.

Claim 5 depends only on claim 1. Claim 1 claims only one consolidation step

and the specification indicates that there is only one consolidation step. Consolidation

temperatures are given in the specification, for example, in the Detailed Discussion on

page 5, lines 16-19, which indicates that consolidation temperatures are typically in the

range of 1200-1900 °C, with a preferred range being 1300-1700 °C. Consequently, the

specification is clear as to the meaning "consolidation" and that the temperature range

for consolidation is 1200-1900 °C, with a preferred range being 1300-1700 °C.

8th Statement

The Examiner's 8th Statement states:

"Claim 21: There is noted that there is no antecedent basis for

"the temperature at which the particles are deposited" = it is

unclear if the claim is directed to the actual deposition

temperature, or if it is directed to the temperature of the deposition

surface."

Claim 21 depends on claim 20 and states that the temperature at which the

particles are deposited is approximately 200 to 500 °C less than the minimum

temperature [required for consolidation].

Claim 20 depends on claim 1 and states that the minimum temperature is

1200 °C

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Claim 1 states that the particles are deposited on a deposition surface below the minimum temperature required to consolidate the particles into a dense glass. One skilled in the art would under that the phrase "minimum temperature required to consolidate the particles into a dense glass" to mean that below this temperature the particles would not consolidate into a dense glass.

In order to properly understand claim 21, it is necessary to discuss the claims in reverse order. That is, in the order of claim 1, then claim 20 and finally claim 21.

First, reading claim 1 in the light of the specification and the drawings, it is clear, to one skilled in the art, that the deposition surface ("bait") is initially located a distance from the burners and that the required distance is one such that the particles being deposited are deposited at a temperature below the consolidation temperature of the preform that is to be formed (page 3, lines 8-10) and ultimately consolidated by heating at a temprature in the range of 1200 to 1900 °C [page 5, lines 16-19]. Since the specification states that consolidation temperatures are in the range of 1200-1900 °C (and preferably within the range of 1300 to 1700 °C), it is clear from the specification that the particles are deposited on the bait at a temperature at below 1200 °C. Knowing the minimum deposition temperature, one skilled in the art would then know that initially the deposition surface ("bait") temperature would be below the consolidation temperature (or else the particles would consolidate). One skilled in the art would also know and understand (after reading the specification at page 4, lines 15-24, and reviewing Figures 1 and 2) that as the soot is deposited the bait is moved or translated away from the burners. This is done in part to maintain the deposition temperature at below the consolidation temperature in the area where the "newly

formed soot" is being deposited as well as to give the preform shape (columnar in this case). One skilled in the art would be able to determine the appropriate distance between the burners so that the temperature of the bait (or that of the preform at the soot deposition site) is below the minimum consolidations temperature. Common instruments such optical pyrometers could be used to make the temperature measurement.

Second, regarding claim 20, Appellants also refer to the Specification on page 5, lines 16-18, which indicates that consolidation temperatures are "typically in the range of 1200 to 1900 °C." A preferred consolidation temperature range is 1300 to 1700 °C. Using this information, those skilled in the art would understand that 1200 °C would be the minimum consolidation temperature and that as a result the soot particles would be collected to make the preform at a temperature of less than 1200 °C.

Third, claim 21 states that the temperature at which the particles are deposited is approximately 200 to 500 °C less than the minimum temperature. Applying this range to the 1200 °C temperature of the 1200 to 1900 °C range, one gets a deposition temperature range of 700 to 1000 °C, which is below the minimum concolidation temperature of 1200 °C. If applied to the 1300 °C temperature of the 1300 to 1700 °C, one gets a deposition temperature range of 800 to 1100 °C, which is alsobelow the minimum concolidation temperature of 1200 °C. Thus, in either case the temperature for deposition is below the minimum temperature required for consolidation.

CONCLUSION

In conclusion, Appellants request a reversal of each of the grounds of rejection maintained by the Examiner. Appellants have shown above by citation of page(s) and line(s) of the specification and reference to the Figures that each item complained of by the Examiner is present in the application as-filed.

Please charge the necessary fees of \$500 for filing the Brief on Appeal to our Deposit Account No. 03-3325. If there are any other fees due in connection with the filing of this Brief on Appeal, for example, an extension of time to make this brief timely, please charge the fee(s) to our Deposit Account No. 03-3325.

Respectfully submitted,

Dated: O. John 31,0007

By: Walk Walter M. Douglas

Registration No. 34,510 607-974-2431

Corning Incorporated

Patent Department SP-TI-03-01

Corning, NY 14831

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8:

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, No. EM087163937US, in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box

1450, Alexandria, VA 22313-1450 on

10131107

Date of Deposit

Julio Jbn

VIII. CLAIMS APPENDIXX

The claims on appeal are as follows.

1. (rejected) A method for producing a fused silica glass containing titania,

comprising:

synthesizing particles of silica and titania by delivering a mixture of silica

precursor and a titania precursor to a burner;

growing a column of solid porous preform by successively depositing the

particles on a deposition surface at a temperature below a minimum temperature at which

the particles can consolidate into dense glass while successively translating the deposition

surface away from the burner; and

subsequently consolidating the porous preform into dense glass.

2. (rejected) The method of claim 1, wherein a translation speed of the deposition

surface is adjusted to maintain a substantially constant distance between an end portion of

the porous preform remote from the deposition surface and the burner during deposition.

4. (rejected) The method of claim 1, wherein consolidating the porous preform into

dense glass comprises heating the porous preform to a temperature in a range from 1200

to 1900°C.

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5. (rejected) The method of claim 1, further comprising dehydrating the porous preform

by exposing the porous preform to a heated, halide-containing atmosphere prior to

consolidation.

6. (rejected) The method of claim 5, where in the heated, halide-containing atmosphere

comprises chlorine.

7. (rejected) The method of claim 5, where in the heated, halide-containing atmosphere

comprises fluorine.

8. (rejected) The method of claim 5, wherein the temperature of the heated, halide-

containing atmosphere is in a range from 900 to 1100°C.

9. (rejected) The method of claim 1, wherein the glass contains 2 to 12% by weight

titania.

13. (rejected) The method of claim 5, wherein a translation speed of the deposition

surface is adjusted to maintain a substantially constant distance between an end portion of

the porous preform remote from the deposition surface and the burner during deposition.

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Application No. 09/844,947

15. (rejected) The method of claim 5, wherein consolidating the porous preform into

dense glass comprises heating the porous preform to a temperature in a range from 1200

to 1900°C.

20. (rejected) The method of claim 1, wherein the minimum temperature is

approximately 1200°C.

21. (rejected) The method of claim 20, wherein the temperature at which the particles

are deposited is approximately 200 to 500°C less than the minimum temperature.

23. (withdrawn from appeal and cancelled) The method of claim 1, wherein a

variation on coefficient of thermal expansion of the dense glass is in a range from 5

ppb/°C to +5 ppb/°C.

24. (rejected) The method of claim 1, further comprising rotating the deposition surface

relative to the burner while successively depositing the particles on the deposition

surface.

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IX. EVIDENCE APPENDIX

A. Evidence

The following are submitted as part of the Evidence Appendix.

- 1. Final Office Action mailed March 12, 2007, pages 36-43 of this document.
- 2. Applicants' Response of May 23, 2007, pages 44-52 of this document.
- 3. Applicants' Response of December 21, 2006, pages 53-60 of this document.

B. Location of Evidence

The patent Evidence above in in the Patent Office File Wrapper. It constitutes an office Action sent by the Examine to applicants during prosecution and applicants' Responses to office Actions.

C. Case law

- Moba B.V. v. Diamond Automation Inc., 66 USPQ2d 1429 (Fed. Cir. 2003), pages 61-69.
- 2. Veerve LLV v. Crane Cam Inc., 65 USPQ2d 1051 (Fed. Cir. 2002), pages 70 72

1. Final Office Action mailed March 12, 2007, pages 36-43 below.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09/844,947	04/27/2001	Bradford G. Ackerman	SP01-095	1336
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Application/Control Number: 09/844,947
Art Unit: 1731

Page 2

/ DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set from the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 4-9, 13, 15, 20-21, 23-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) //c contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention.

- (2) Examiner could find no support for the claimed "column of solid porous preform", or "solid porous", "while successively translating", "a deposition surface at a temperature is below a minimum temperature at which the particles can consolidate" either explicit or implicit. This is deemed to be a prima facie showing on failure to comply with the requirement. The burden is now on Applicant to show the requirement is complied with, or to amend the claims so that they comply.
- Moreover, it is clear that at least the temperature limitation and "while successively translating" cannot be implicitly supported because they are impossible. The terms "while" and "successively" are two mutually exclusive condititions: while means simultaneously, and "successively" means following each other. Nor can a translating be successive with itself at best it would have to be successive with some

> Application/Control Number: 09/844,947 Art Unit: 1731

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other translating. But there is NO support for two successive translations (that Examiner can find) – Applicant cannot now claim two successive translations when the specification does not provide support therefor. As to the temperature limitation, the particles could not stick to the support or to each other if the temperature is as low as C claimed. In other words, Applicant is correct in arguing that Blackwell does not meet the temperature limitation – but for the same reason, Applicant's invention does not provide support therefor.

Either something is solid or it is porous, it cannot be "solid porous" – or if it could possibly be, there would have to be support for such in the specification. The only

\[\text{O} \text{ mention of "solid" in the specification that Examiner could find is in reference to dense, non-porous glass. \]

There is no support for claims 20-21. Applicant does not dispute this, thus it deemed that applicant acquiesces on this point.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification that conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the explicate regards as his invention.

Claims 1-2, 4-9, 13, 15, 20-21, 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has not disputed this rejection, thus it deemed that applicant

BO acquiesces that the claims fail to particularly point out and distinctly claim the subject
matter.

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Claim 1: It is not understood what is meant by "column of solid porous preform" – is unclear if it means "column of solid glass or a porous preform", or "a porous column of solid preforms" or something else. As alluded to above, the term "solid porous" is indefinite as to its meaning. And, it is unclear what is meant bye "while successively" – since these two words connote mutually exclusive conditions (see above).

Claim 5: It is unclear if the "consolidation" refers to the consolidating step of claim

1, or if it is open to any consolidation.

Claim 21: There is noted that there is no antecedent basis for "the temperature at which the particles are deposited" – thus it is unclear if the claim is directed to the actual deposition temperature, or if it is directed to the temperature of the deposition surface.

Response to Arguments

Applicant's arguments filed 21 December 2006 have been fully considered but they are not persuasive.

Regarding the 112 -first paragraph rejection of "column of solid porous preform", applicant points to specific lines in pages 2-5 of the specification. Whereas these lines do support a limitation of making a "porous column", a 'columnar porous preform' or a "porous preform' and then converting it into a "solid preform" or a "solid column", such does not support the newly created limitation of "column of solid porous preform" – as far as examiner can tell. Nor does applicant point out how these lines support this new limitation.

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Applicant goes on to point out that since particles are made of solids, the result is a solid preform. This is an assertion that is prima facie unreasonable. Examiner can find no definition for "solid" that means composed of solids. By applicant's reasoning, one can consider a slurry as being a solid, because it too is comprised of solid particles. Since applicant has not defined or otherwise set forth in the as-filed application that "solid" is to mean anything else but is customary usage, the claim is interpreted using the customary definition.

As pointed out previously, the present specification only uses the term "solid" in reference to dense, non-porous glass. Since applicant does not dispute this finding by the Office.

Regarding the "while successively translating" rejection, applicant refers to page 2, page 4 and the abstract. Applicant points out that particles are deposited while the surface is rotated and translated. The relevance of this is not understood. The claim does not rectle merely "while translating", rather the claim requires "while successively translating". Since applicant has failed to point out the basis for the "successively" portion of the claim, applicant has failed to show that 35 USC 112 –first paragraph is

Regarding the limitation of a "temperature below a minimum temperature at which the particles can consolidate", applicant points to page 3, lines 8-10 and pages 1-2. A review of the cited passages indicates that invention does not require cepturing the soot "at consolidation temperatures". This is deemed to be insufficient because this passage only refers to the temperature of the soot – it gives no indication of the

Application/Control Number: 09/844,947
Art Unit: 1731

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temperature of the deposition surface. The limitation which is rejected refers to the temperature of the deposition surface, not the soot particles. Whereas in other situations this might appear to be splitting hairs — such is not case when one reviews the entire prosecution history. Most notably, at pages 5-6 of the Appeal Brief of 4/12/2006 applicant argues that the substantially identical process of Blackwell has temperatures at which (partial) consolidation takes place. Thus it is deemed that if Blackwell has consolidation, so do's applicant. The plain meaning of "consolidate" is "to join together into one whole", Since applicant clearly consolidates the particles, there must be something at a temperature which is not below the minimum temperature which permits consolidation.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.135(a) will be calculated from the mailing date of

> Application/Control Number: 09/844,947 Art Unit: 1731

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (INUSA OR CANADA) or 574-274-440.

John Hoffmann Printary Examiner

imh

2. Applicants' Response of May 23, 2007, pages 44-52.

Appl. No.: 09/844,947 Amdt. Dated: 23 May 2007 Reply to Office Action of: March 12, 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

: 09/844,947 Appl. No.

Applicant

: Bradford G. Ackerman

Filed : April 27, 2001 Title

: METHOD FOR PRODUCING TITANIA-DOPED FUSED SILICA GLASS

TC/A.U. Examiner

: 1731 : John M. Hoffmann

Docket No. : SP01-095

Mail Stop: Amendments Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

AMENDMENT

In response to the Office action of March 12, 2007, please amend the aboveidentified as follows:

Amendments to the Specification begin on page 2.

Amendments to the Claims are reflected in the listing of claims which begins on page 3 of this paper.

Remarks/Arguments begin on page 6 of this paper.

Appl. No.: 09/844,947

Amdt. Dated: 23 May 2007

Reply to Office Action of: March 12, 2007

Amendments to the Specification

Please amend the Specification on page 3, lines 2-13 as follows (insertions underlines, deletions struck through):

Embodiments of the invention provide a method for producing SiO₂-TiO₂ glass substrates with low variations in CTE within the substrate. The method involves transporting silica and titania precursors in vapor form to deposition burners. The precursors exit the deposition burners where they react to form fine SiO₂-TiO₂ particles ("soot"). The soot collects on a deposition surface to form a porous preform. The method further includes consolidating the porous preform to give a dense SiO₂-TiO₂ glass in a separate step. Consolidating the glass in a separate step climinates the need to capture the soot at consolidation temperatures. This allows the soot to be deposited at lower temperatures (typically, 200°C to 500°C lower) than possible with the conventional boule process. That is, the silica and titania particles are deposited at a temperature below that required to consolidate the porous perform into dense glass, SiO₂-TiO₂ glass having low OH content can be produced by exposing the preform to a dehydrating agent, such as chlorine or fluorine, prior to consolidation. Chlorine and/or fluorine treatment would also remove impurities from the glass which could result in seeds.

> Appl. No.: 09/844,947 Amdt. Dated: 23 May 2007 Reply to Office Action of: March 12, 2007

The listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

 (amended) A method for producing a fused silica glass containing titania, comprising:

synthesizing particles of silica and titania by delivering a mixture of silica precursor and a titania precursor to a burner;

growing a column-of-solid columnar porous preform by successively depositing the particles of silica and titania on a deposition surface at a temperature below a minimum-temperature at-which the particles can consolidate that temperature required to consolidate the porous preform into dense glass while successively translating the deposition surface away from the burner; and

subsequently consolidating the porous preform into dense glass.

- 2. (previously presented) The method of claim 1, wherein a translation speed of the deposition surface is adjusted to maintain a substantially constant distance between an end portion of the porous preform remote from the deposition surface and the burner during deposition.
- 3. (cancelled)
- 4. (previously presented) The method of claim 1, wherein consolidating the porous preform into dense glass comprises heating the porous preform to a temperature in a range from 1200 to 1900°C.
- (original) The method of claim 1, further comprising dehydrating the porous preform by exposing the porous preform to a heated, halide-containing atmosphere prior to consolidation.

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- (original) The method of claim 5, where in the heated, halide-containing atmosphere comprises chlorine.
- (original) The method of claim 5, where in the heated, halide-containing atmosphere comprises fluorine.
- (original) The method of claim 5, wherein the temperature of the heated, halidecontaining atmosphere is in a range from 900 to 1100°C.
- 9. (original) The method of claim 1, wherein the glass contains 2 to 12% by weight titania.
- 10. 12 (previously cancelled)
- 13. (previously presented) The method of claim 5, wherein a translation speed of the deposition surface is adjusted to maintain a substantially constant distance between an end portion of the porous preform remote from the deposition surface and the burner during deposition.
- 14. (previously cancelled)
- 15. (previously presented) The method of claim 5, wherein consolidating the porous preform into dense glass comprises heating the porous preform to a temperature in a range from 1200 to 1900°C.
- 16. 19. (previously cancelled)
- (previously presented) The method of claim 1, wherein the minimum temperature is approximately 1200°C.

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- (previously presented) The method of claim 20, wherein the temperature at which
 the particles are deposited is approximately 200 to 500°C less than the minimum
 temperature.
- 22. (cancelled)
- 23. (previously presented) The method of claim 1, wherein a variation on coefficient of thermal expansion of the dense glass is in a range from -5 ppb/°C to +5 ppb/°C.
- 24. (previously presented) The method of claim 1, further comprising rotating the deposition surface relative to the burner while successively depositing the particles on the deposition surface.

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REMARKS/ARGUMENTS

1. Oath/Declaration

Acknowledgement has not been made as to the acceptance of the Declaration filed December 21, 2006.

2. Drawings

Applicants thank the Examiner for indicating in the form PTO-948 dated May 13, 2004 that the formal drawings previously submitted have been approved.

3. Specification

The specification has been amended by incorporation of the language of original claim 13 into the paragraph on page 3, lines 2-13. Since this language appeared in the claims of the specification as-filed, applicants submit that this amendment does not introduce new subject matter into the specification.

3. Claims

Claims 1, 2, 4, 9, 13, 15, 20, 21, 23 and 24 remain in the application. The independent claim is claim 1. Claims 2, 4, 9, 13, 15, 20, 21, 23 and 24 depend on claim 1 either directly or indirectly by means of an intervening dependent claim.

Claim 1, line 7, has been amended herein to read "a column of solid columnar porous perform" as described in the Specification on page 5, lines 5-6; and has been further amended by deletion of the word 'successively' from the phrase "successively translating". Claim 1 has further been amended as follows (insertions underlined, deletions stuck through)

"... depositing the particles of silica and titania on a deposition surface at a temperature below a minimum temperature at which the particles can consolidate that temperature required to consolidate the porous preform into dense glass ..."

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Applicants believe that the foregoing amendments overcome the Examiner's rejection described below regarding the use of the word 'while' and "successively" following one another. Buther, there is

3. § 112 Rejections

The Examiner has rejected claims 1, 2, 4 – 9, 13, 15, 20, 21, 23, and 24 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirements for reasons set forth in the Office Action.

Regarding the Examiner's rejection of the phrases "a column of solid porous perform" and "successively translating," applicants submit that these rejections are moot in view of the amendments submitted herein (insertions underlined, deletions struck through) so that these phrases read "a solumn of solid columnar porous perform" and "successively translating," respectively. [See further comments in the second paragraph below.]

Regarding the Examiner's rejection of the phrase "a deposition surface at a temperature below a minimum temperature at which the particles can consolidate," this amendment is believed moot in view of the amendment to claim 1 and the specification, both of which use the language of original claim 13 in the application as-filed.

Regarding the Examiner statements concerning use of "while" and "successively" together, applicants submit that this rejection is not moot in view of the amendment described above in which the word "successively" was deleted. Using Figure 1 and the specification at page 4, lines 15-24, and page 5, lines 1-13, it is clear to one skilled in the art that during the deposition process the bait 34 on spindle 36 are "translated" or moved upward.

Finally, the Examiner states that the particles could not stick together if the temperature were as low as applicants' claims. This is interpreted as saying that the particles would not stick together at temperatures below consolidation temperatures. However, This is exactly what applicants' specification teaches; namely, that one can form a preform at temperatures below consolidation temperatures. Applicants refer the Examiner to the specification at page 3, lines 8-9 in which applicants state:

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> > Consolidating the glass in a separate step eliminates the need to capture the soot at consolidation temperatures."

The Examiner also states that something that not be both "solid porous." The Examiner is in error with this statement. Molecular sieves are a well known "solid porous" materials. Applicants submit that these grounds for rejection should properly be dismissed.

The Examiner also states that applicant has acquiesced that there is no support for claims 20 and 21. Applicants traverses. Claims 20 and 21 are as follows.

20. (previously presented) The method of claim 1, wherein the minimum temperature is approximately 1200°C.

21. (previously presented) The method of claim 20, wherein the temperature at which the particles are deposited is approximately 200 to 500°C less than the minimum temperature.

Regarding claim 20, applicants refer the Examiner to the Specification on page 5, lines 16-18, in which applicants indicate that consolidation temperatures are "typically in the range of 1200 to 1900 °C." The lower temperature is 1200 °C. Those skilled in the art would understand that 1200 °C would be the minimum consolidation temperature. Applicants also refer the Examiner to page 3, lines 5-7 which indicate (1) that performing consolidation in a separate step allow eliminates the need to capture soot at consolidation temperatures and (2) that this allows the soot to be deposited at lower temperatures, typically 200 to 500 °C lower than in conventional boule processes. Applicants submit that the specification supports both claims 20 and 21 and that one skilled in the art would understand this and would understand exactly what these claims mean.

THEREFORE, in view of the foregoing amendments and the comments offered herein applicants submit that the foregoing 35 U.S.C. § 112, first paragraph, rejection of claims 1, 2, 4-9, 13, 15, 20, 21, 23, and 24, as they may have been amended herein for clarity, may properly be withdrawn.

The Examiner has rejected claims 1, 2, 4 - 9, 13, 15, 20, 21, 23, and 24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out

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and distinctly claim the subject matter with applicants regards as the invention.

Applicants traverse the rejection.

Applicants submit that the rejections given under 35 U.S.C. § 112, second paragraph, are moot in view of the amendments made to the specification, for clarity, and the arguments given above which are incorporated herein in their entirety.

4. Conclusion

Based upon the above amendments, remarks, and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims and a prompt Notice of Allowance thereon

Applicants hereby respectfully request that in the event that an extension of time is required to make this response timely, that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Walter M. Douglas at 607-974-2431.

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Walter M. Douglas
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Corning Incorporated
Patent Department

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Respectfully submitted, CORNING INCORPORATED

3. Applicants' Response of December 21, 2006, pages 53-59.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

09/844,947 Bradford G. Ackerman et al.

April 27, 2001
METHOD FOR PRODUCING TITANIA-DOPED FUSED
SILICA GLASS

1731 TC/A II Peter Chin Examiner

SP01- 095 Docket No. :

Mail Stop: Amendments Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

AMENDMENT

In response to the Office Action of December 14, 2006 and the Office Action mailed June 6, 2006, originally responded to by mail on October 25, 2006 with a two (2) month extension of time to make the response timely.

Please amend the above-identified application as follows:

Amendments to the Specification begin on page 2 of this paper

Amendments to the Claims are reflected in the listing of claims which begins on page 3 of this paper.

Remarks/Arguments begin on page 6 of this paper.

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Amendments to the specification

On page 2, after the paragraph ending at line 22, please insert the following paragraph:

In another aspect the method of the invention is directed to synthesizing particles of silica and titania by delivering a mixture of a silica procursor and a titania precursor to a bunner, growing a porous preform by successively depositing the particles on a deposition surface (herein also called a "bait") while rotating and translating the deposition surface relative to the burner, consolidating the porous preform into a partially dense glass.

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The listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

 (currently amended) A method for producing a fused silica glass containing titania, comprising:

synthesizing particles of silica and titania by delivering a mixture of silica procursor and a titania precursor to a burner;

growing a column of solid porous preform by successively depositing the particles on a deposition surface at a temperature below a minimum temperature at which the particles can consolidate either partially er-faily into dense glass while successively translating the deposition surface away from the burner; and

subsequently consolidating the porous preform into dense glass.

- (previously presented) The method of claim 1, wherein a translation speed of the deposition surface is adjusted to maintain a substantially constant distance between an end portion of the porous preform remote from the deposition surface and the burner during deposition.
- 3. (cancelled)
- 4. (previously presented) The method of claim 1, wherein consolidating the porous preform into dense glass comprises heating the porous preform to a temperature in a range from 1200 to 1900°C.
- (original) The method of claim 1, further comprising dehydrating the porous preform by exposing the porous preform to a heated, halide-containing atmosphere prior to consolidation.
- (original) The method of claim 5, where in the heated, halide-containing atmosphere
 comprises chlorine.
- (original) The method of claim 5, where in the heated, halide-containing atmosphere commises fluorine.

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- (original) The method of claim 5, wherein the temperature of the heated, halidecontaining atmosphere is in a range from 900 to 1100°C.
- 9. (original) The method of claim 1, wherein the glass contains 2 to 12% by weight titania.
- 10. 12 (previously cancelled)
- 13. (previously presented) The method of claim 5, wherein a translation speed of the deposition surface is adjusted to maintain a substantially constant distance between an end portion of the porous preform remote from the deposition surface and the burner during deposition.
- 14. (previously cancelled)
- 15. (previously presented) The method of claim 5, wherein consolidating the porous preform into deuse glass comprises heating the porous preform to a temperature in a range from 1200 to 1900°C.
- 16. 19. (previously cancelled)
- (previously presented) The method of claim 1, wherein the minimum temperature is approximately 1200°C.
- 21. (previously presented) The method of claim 20, wherein the temperature at which the particles are deposited is approximately 200 to 500°C less than the minimum temperature.
- 22. (cancelled)
- 23. (previously presented) The method of claim 1, wherein a variation on coefficient of thermal expansion of the dense glass is in a range from -5 ppb/°C to +5 ppb/°C.

> Appl. No.: 09/844,947 Amdt. Dated: October 25, 2006 Renly to Office Action of: June 6, 2006

REMARKS

1. Claims

Claims 1, 2, 4-9, 13, 15, 20, 21, 23 and 24 remain in this application. Claim 1 has been amended herein. Claim 1 is the only independent claim in the application. Claims 2, 4-9, 13, 15, 20, 21, 23 and 24 depend from claims 1 either directly or indirectly.

Claim 1 has been amended by deleting the phrase "either partially or fully" so that the claim now reads "... can consolidate either-partially or fully into dense glass ..." While the specification does indicate that in the present invention the deposition temperatures are 200 - 500 °C lower than conventional processes which require the particles (soot) to be deposited at consolidation temperatures. [See page 3, lines 8-10.]

Applicants believe that the foregoing amendment does not introduce new matter into the specification.

2. 35 U.S.C. §112 rejection

Claims 1, 2, 4-9, 13, 15, 20, 21, 23 and 24 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states that he could:

"find no support for the claimed [1] "column of solid porous perform" (or any other column), or [2] "solid porous", [3] "while successively translating", [4] "a deposition surface at a temperature below a minimum temperature at which the particles can consolidate either partially or fully into dense glass: - either explicit or implicit. This is deemed to be a prima facie showing on [sie] failure to comply with the requirement. The burden is now on Applicant to show the requirement is complied with, or to amend the claims so that they comply." [Numerals added.]

Applicants submit the following to show that the claims are fully supported by the specification.

 Regarding [1], the phrase complained of is fully supported by the specification; for example, at on page 2, lines 18-22; page 3, lines 5-6 and 20-21; page 4, lines 15-19; page 5, lines 3-8; the Abstract, and Figure 1. Page 2, lines 18-22 describes synthesizing particles ("soot", see page 3, line 5) by delivering a silica procursor and a

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> > titania precursor to burner and growing a porous perform by depositing the particles a on a deposition surface while rotating and translating the deposition surface relative to the burner. Particles are solids. Consequently, the perform that is formed is a solid perform. Combining these lines with Figure 1, particularly elements 34 and 40, and the specification on page 4, lines 15-19, it is clear that the preform can be formed on the "bait" (a term of art that describes a deposition surface) and that the perform can be formed in the form of a column. The column will be formed as one continues to raise spindle 36 while depositing the particle on perform 40 as it grows (see page 5, lines 7-8). In view of the foregoing, applicants submit that all the term of [1] that is complained of have been fully set forth in the specification.

- Regarding [2], see [1] above. Particles are solids and the particles are used to form the "porous perform." Hence, implicitly the porous perform form by particles is a solid preform.
- 3. Regarding [3], the phrase complained of fully supported by the specification on page 2, lines 18-22; page 4, lines 15-24 and the Abstract. These lines clearly indicate that particles (which are solids) are deposited to form a porous perform while the deposition surface (the bait) is being rotated and translated. In view of the foregoing, applicants submit that all the terms of [2] that are complained of have been fully set forth in the specification.
- 4. Regarding [4], claim 1 has been amended to remove the phrase "... either-partially-es-fully..." as described above in Section 1 of these remarks. With regard to the remainder of the phrase complained of, please refer to the specification on page 3, times 8-10, and also page 1, line 28, to page 2, line 7. The latter refers to "conventional processes" in which the soot (particles) is captured at consolidation temperatures, a process which leads to problems such as variations in composition which in turn lead to non-uniform thermal expansion properties. In contrast, the invention as described on page 3, lines 8-10, clearly indicates that the present invention eliminates the need to capture soot at consolidation temperatures. The present invention allows one to capture soot at temperatures 200-500 °C lower than the conventional process.

> Appl. No.: 09/844,947 Amdt. Dated: October 25, 2006 Reply to Office Action of: June 6, 2006

Applicants respectfully submit that in view of the foregoing facts and arguments, the invention as now claimed is fully described in the specification. Consequently, applicants respectfully submit that it is proper for the Examiner to withdraw the §112, first paragraph, rejection of claims 1, 2, 4-9, 13, 15, 20, 21, 23 and 24.

3. Oath/Declaration

The Examiner has indicated that the oath/declaration is defective because it did not identify the application by number and filing date. A new oath/declaration is enclosed with this paper.

4. Conclusion

Applicants respectfully submit that all items listed in the Office Actions have been treated herein, and that the pending claims are now in condition for allowance. If there are further items whose speedy resolution would facilitate prosecution and allowance, applicants' undersigned attorney respectfully requests that the Examiner call him so that the items can be discussed and if possible suitable amendments entered into the case by Examiner's agreements.

Applicant believes that a two (2) month extension of time is necessary to make this Reply timely. Applicants respectfully request that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Walter M. Douglas at (607) 974-2431.

Date

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Moba B.V. v. Diamond Automation Inc., 66 USPQ2d 1429 (Fed. Cir. 2003), pages 60-69

۱.,	copyright infringement and violations of the		Lexmark's Proposed Fundings on teach conclusions of Law where appropriate.
from such losses are difficult to compute."). 104 1 e-mark's notential damages are diffi-	DMCA in the name of competition.	various uniel, however, have provided dule	ORDER
cult to measure or quantify, and thus Lexmark will likely suffer irreparable injury absent an	VI. THE POSSIBILITY OF SUBSIANT TIAL HARM TO OTHERS		In accordance with the Findings of 17st and Conclusions of Law entered on the same date
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N THE PUBLIC INTEREST FACTOR	(consist software) do not give [SCC]	tends that the (straines of	mark") motion for a prelaminary in- junction is GRANTED.
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CONCRETE Mach., 843 F.2d at 612. Purther, "It	will cause harm, See Candence, 125 F.3d at	that accept the up-front discount when pur-	Leanning Tolkhold and Judger
is virtually axiomatic that the public interest	529 (the distinct court error by giving nor proper emphasis to harm to defendant that	quently required to compily with the Prebate	from this Court, and
protections and, correspondingly, preventing	would deverate its business, "a defendant	agreement and return the used cartroges to	(3) the bond previously posice of
the misappropriation of the skills, creative en-	cannot complain of the harm that will befull	Cextrant	ther Order from this Court.
protected work." Franklin Computer, 714	it when properly forced to desist from its in-	VII. LEGAL CONCLUSION	
F.2d at 1254. Moreover, a preliminary injunc-	714 F2d at 1255 (reversing district court's de-	112. Lexmark is likely to prevan to	and and and and
the copyright laws which seek to encourage	nig/ of a preliminary injunction because of its	DMCA daims. It is presumed that Lexinary	Moba B.V. v. Dlamond Automation 1:00
individual effort and creativity by granting	hers: "[1]f [the effect on the defendant] were	will suffer inspirate them in the second of	U.S. Court of Appeals
at 620.	the correct standard, then a knowing infringer would be permitted to construct its business	presumption. Bred in the absence of this pre-	Federal Carolli
106. SCC contends that policies of the United States government favor the recycling	ground its infringement, a result we cannot	fer impurable form it is further presumed	Decided April 1, 2003
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turber cams one as injunction spine	Toner Loading Programs and purposely devel-	sumption. Byen in the absence of this pre-	
to the environment." SCC Opp. at p. 30. This	oped and sold a product that circumvents use access control measure that protects Lex-	sumption, it is clear that the public interest in	(1) Patent construction — Claims — Become or narrow (§ 125.1303)
argument rests primarily upon the assumption that the majority of Lexmans's Probate toper	mark's copyrighted works. Thus, under the	violations of the DMCA. SCC contends that	Delta de la Calma - Dello
carnidges will end up in landfilly should be	circumstances, the "Court should not consider a behaviour of hardehire as a determining fac-	certain third parties could be harmed should	ing terms (§ 125.1305)
the Court enjoin SCC from trafficting in its SMAPTEX mirrorline. The Court flods this	tor in granting injunctive relief in a copyright	finds these claims to be unpersuasive. The	HENCHAL PRACTICE AND
chain to be largely unabhampland Learnard,	matter" because "(a)llowing for a balancing	Court has fully considered the four prelimi-	URE
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gument that an injunction will threaten signifi-	124 USPOZd 1331] (D.N.J. 1992) (clting	CONCILISION	jury to import additional limitation tito
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of multiple remanufactures for toners car-	ourweight the harm that SOC would likely	graphed by Order of this Court, contemporation	
tridges, SCC further contents that public	suffer because often injunction.	outly entered is accordance with	
tures to prevent or limit remanufacturing. The	B. Third Parties	founding this decision, the Court has adopted	
Court has no trouble accepting Sec. 3 than that making notice generally favors competi-	110. As has been stated by SCC and vari-	A majority of Lexinary 3 regions	
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and principle only favors legitimate competi-	instant care could tave a significant impera- uoen the toner cartridge remanufacturing in-	view of this matter and has made durings to	
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The section many of the section of t	"A district court may overturn a jury"s	at only if upon the record before the just- mable jurest could not have restrict that c LIVP Eug. & Pleasing, fine, x Miller c LIVP Eug. 4, 147, 1533, 61	A Mills, Mr., 200, 100 (100 dolls). And Lips, High Ged Cir. 2001). And inspurge delines claim scope. SRI Advantable Elec. Corp. 775 P24 (10).	227 USPO 577, 386 (Fed. Cif. 1962) board). As a general rule, claim language	normal usage of the field of the invention.	S, 1299, 53 USPQ2d 1065, 1067 (Fed. Cit.	own lexicographer and use the specifica-	dicidy or by implication. Markens v. West-	121, 1321, 1330 (Feb. Ch. 135) 1461 16), of 4, 517 U.S. 370, 38 USPQ2d 1461	struction of a patent claim, a construing	an contains the protectation history. Id. at each one of the contains the protectation history. Id. at	After claim construction, the fact finder	e alegedly infringing devices. Nameo Sales, Course Papers Co., 208 F.3d 1352,	560, 54 USPQ2d 1308, 1312 UPG. CI. 500). Infringement requires the patenties to 500). Infringement requires the patenties of per-	now that the months of the suscented claim, and the fact that 156	3d 1206, 1211, 48 USPQ2d 1010, 1014-13	imitation not satisfied literally, Maries	20 U.S. 17 [41 USPQ2d 1865] (1997). 175	within the meaning of 35 U.S.C. § 271(a).	1579, 28 USPQ2d 1081, 1100 (Fed. Cir.	In this case, the record shows that FPS's In this case, the method of the Moba Omnia	to process eggs in the United States. Hence, to thought infringement Diamond needs only to	prove that the Moba Omnia perunial method of claim 24 when it processes 6824.	"guiding steps"	[1] Based upon its chain construction, we district court instructed the jury, in relevant	part, that the guiding steps of change defined as follows: (1) Carrying eggs to hold-	
the territory of the control of the	Moba B.Y. v. Diamon										8.58				determination that claim 24 of the '505 patent St determination that claim 24 of the '505 patent St and claim 25 of the '494 patent are not invalid. It		elaim 34 of the '494 percent, this court need not	diction over the present appeal under an U.S.C. § 1195(a)(1) (2000).					Some Service Lat. 1 Serv. Ext. 1 Corp., 216 100. Embret. Inc. 1, Serv. Ext. 1 Corp., 216 100. 1347. 1348-45, 55 USPQZd 1161, 1164	(Fed. Cir. 2000).	of IMOL without deference, reverting only it	fermal findings or if the law culture sys- the legal conclusions underplaining the jury's fermal findings. Oybor Corp., 138 F3d at	
	Moba B.V. u. Diamond Automation Inc. 66 USPQ2d	delivering eggs to said receiving station in parallel spaced apart rows on said first connection means	released eggs from said first conveyor means if the receiving station in accordance with a newdorterminal resolution.	positioning a receiving means below the	first conveyor means so as to receive therein and deliver to a common member	ne eggs reicked from the paramet spacer spart rows of the first conveyor means,	receiving said eggs in the receiving means disposed at said receiving station	whereby the released eggs from both said.	re received by said receiving means, uing the receiving means downwardly	and away from said first canveyor means to urge the received eggs downwardly,	guiding said eggs received in said receiv-	receiving means, and	conveying said eggs away from said re- teiving means on second conveyor means,	said step of releasing comprising releas-	conveyor means at said receiving station along the length of said receiving means.	aid step of conveying comprising con- g said eggs individually in rows zway	from said receiving means on said second conveyor means.	494 patent, col. 12, II. 9-40 (emphasis addod).	Mobs, B.V., and Staatlest, B.V., are Datch companies that also manufacture and stell	ted egg processing machines, such as be Omnia and the Staallest Selecta.	FPS Food Processing, a remayivana curpo- ration, sella Moba's and Stankar's egg pro- mation in the Haited State. In the	States market, FPS and Dismond are	facture and sale of high-speed egg processing machines.	In 1994, Diamond filed a patent infringe- ment sult in the United States District Court	for the Eastern District of Michigan against	filed suit in the United States District Court for the Eastern District of Permaynvatia spek-	polaratory judgment that the see, wow,

-			- Section rises 1990	Superior Contribution	THE PROPERTY OF THE PROPERTY O
	control of	in sum, the evidence of record consistent that the correct claim consultations above that the method performed by the Moha Omman in- cludes all face "priding steps" and that the claim moves ago a "badding steps". Be- man on passonable juty could find on the eases no reasonable juty could find on the	the district of the method professional by the Modes Comais does not attituge literally and detectly claim 24 of the '503 patent, the attitude count errold in not granting MOU, on that issue. B.	Thenge to chain 2 of the 700 spears to general departs departs the desired to the country of the Illusions "predestations" resembnated to putter and you limitations well please to consider the putter of Communication of the putter of Communication of the putter of Communication of the Communication of	
66 USPQIA	8024 0504			to the orchest organize, No. 16, 30 part, col. 11, 445, 30 th, 11, 45 part, col. 11, 445, 30 th, 11, 45 part, col. 11, 445, 30 th, 11, 45 part, col. 12, 45, 30 th, 11, 45 part, col. 12, 45 par	Only of Paging Contemp (Let 4, 1989). The saming is in important to represent the saming is in important to represent the saming is in important to the saming contemp (Let 4, 1984). The saming is in important to the saming (Let 4, 1984) and the sam
Mahr R.V. a. Diamond Automation Inc. 66 USPQ2d	when consider outside of the plan is a control	manne or the virtuou grounds space, course, such a contraction is contract to the virtual parameter of the Violo patern. For example, the performance of padeing steps two and three contractions of the virtual parameters of the virtual contractions of the	the statement production of a few statements of the few statements of promising at a 10 miles of 10 per statement of 10 per st		
Mahr R.V. v. Diamo	sions. (D. Currier, see helishen to be speech at helishen to be speech to be s	to the district court's construction of "guiding steps." In this, the district court erred. Claim construction is a question of law and us on the province of the jury. Markman, 52 F.3d at: 979. 779.	peal because the jusy found that the Moby Ominat does not lifeting. These record before us displaces no alternative busis upon which a rescencible layer could find that the Mobb Om- nia does not lifeting, other than that the Mobb Ominat does not statisfy the guiding steps limi- sion. Thus I be allowing the involve intentity	interestination literates in the driver, the driver court fractionarising altered by worlds. The second fractionarising altered by worlds. The second fractionarising control of the driver court claim construction to literate on the pay. PS control the District part of the driver court claim construction to the pay of the driver court claim court as payed to define court claim court cannot be a payed to define court claim court court claim	Comparary (a. D. De H. J. L.) 190, 39 (1872) 190, 39 (1972) 191 (141) (141) (142) (141) (1

shoosed division. Implicit in this count's dater-	mington was the factor of our bear one proposal as the control of	The Parish of these I PSY (150, 2) 121 (1904). Therefore, Investigate of the state
		ment is the effect of the effe
66 USPQ24	and precision the man precision that may precise the state of the property of	and a short or a serious relation of the control of
d Automation Inc.	And the state of t	Some States are not mixture of the states of
Mobe B.K. a Diamond Automation Inc.	the complete for the first state of the first state	the many departs of the second

nects material nec- stantial record evidence. Therefore, the trial	count out to the state of an adequate written de- scription. R.	The patent specification must disclose in- terment complete to crable those skilled in	the art to make and use the claimed investion.	35 U.S.C. § 112 11. 108 some experimed hown-	tion is permissible, so long as it is not undue. After Popular Co. v. E.L. DuPout De Nemours	& Co. 750 F2d 1569. 1576, 224 USPQ 409.	413 (Ped. Cir. 1984). Emilionetti unoc. 1884. Li 18 a question of law thin this	court reviews de novo. Moleculos Research	USPQ 805, 810 (Fed. Clr. 1986). This court	reviews a jury's underlying tactors upon man-	dence, Mitrabiahi Elec, Corp. v. Ampes Corp.	(Ped Clr 1999).	- 8			art would require to develop the conveyor lift.	ing system of the Mosa Onnus in the co. 505 patent disclosure. Rather, FPS asked the	jury, and asks this court to draw the inference	general testimony of the development of that	from the disclosure of the 505 patest. The	trial court found that evidence insufficient to	court holds that substantial evidence supports	the vertical of the just time cannot be invalid for lack of cashlement.	Ü	Anticipation under 35 U.S.C. § 102 re-			5ci. 34 F3d 1048, 1024, 32 Osrveta 1011 1019 (Ped. Cir. 1994). This count reviews a ju-			.5 1	
1		ed to a particular,									art 14, st 1563-64 ("the applicant must		(emphasis in empiral); Union Oil Co. of Col.	Alicanic Richfield Co., 208 F3d 969, 591,	("The written description requirement does	the subject matter daimed, [instead] the de-	nery skill in the art to recognize that the or	. 7.2	showed that the specification that taught one		i indi	a particular form of disclosure because one of	that the inventor possessed the invention at	the time of filling. Accordingly, substantial evidence supports	the jury's finding that the '505 puteof is not in-	ton. The '905 patent specification describes	every element of claim 24 in sufficient occur	recognize that the inventor possessed the in-	the the 505 putent does not adequately dis-	close lifting eggs from a moving conveyor	in the close of a validity challenge. As fooded,	would discen possession of the investment of the time of tiling, a finding supported by sub-
818	E 2 1	i d d	8 E	92	1 4	e i	1	a sign	2 C	1	3 8	ancient E	60	38	1		1		609			*		4	Spes	onlo	神	o race	B B B B B B B B B B B B B B B B B B B	695 6	i te	11
Moba B.V. v. Diamond Automation Inc. 66 USPQ26	canno ocentration requirement of the paragraph." In Genry Guillery, the pasentee described in the specification a rectional soft with a curver the specification a rectional soft.	console including rectains controls. Like speci- fication as filed clearly identified the comode as the only possible location for the controls.	From the specification, it was clear that the	to the center console "to be an essential	ment of his invention." Gentry Gallery, 134 F.3d at 1479. Hence, this court limited the	scope of the patentic's citims to a sofa with	ingly, [the parentee's] original disclosure	serves to limit the permissible ofcession of ma- later-drafted claims." Id. at. 147 (emphasis	added). Thus, because Gentry Gallery app	its original filing, it does not apply in this	where FPS made no allegation at all that the disclosure of the '505 patent did not show pos-	session of a later-filed claim.		the University of Cauporna w Est Listy & Co., 119 P3d 1559, 43 USPQ2d 1398 (Fed. Cir.		only Issues. Invoking \$ 112, Lilly required a				the deposited biological material recited	precise "structure, formula, chemical ment, or physical properties" required by Lilly, Id. at	1324 (quoting Lily, 119 F3d at 1566)	specification in Erzo did not satisfy the Lilly	-	PE S		-		-		ងី ទី	More recently, in Enzo Biochem, we clair feed that Ell Lilly did not hold that all func-
438 Moba B.V. v. Diamo	this court's prodecessor tempurated tole of \$112 to prevent the addition of one marker to claims. In re Runchig, 379 R2d 990, 154 USPQ 118 (CCPA 1967). As this court's pre-	decessor noted, "(the function of the descrip- tion requirement is to ensure that the inventor	had possession, as of the hinty dans of the ap- plication relied on, of the specific subject mai-	er later claimed by him." In re Werthelm, 541 F2d 257, 262, 191 USPQ 90, 96 (CCPA	976). Although the stants proscribes addi-	tion of new matter to a specification of culture ander § 132, the United States Court of Our-	toms and Parent Appeals decided to police the	uing § 112. In re Rasmusren, 650 F.2d 1212,	14, 211 USPQ 323, 325-26 (CCPA 1981).	of \$ 132 or \$ 112 was synonymous became	"a rejection of an amended cisim under § 134. is equivalent to a rejection under § 112, first	paragraph." Id. Since then, this court has con-	d possession at the time of filing of subject	matter subsequently elamon. In this counts most recent application of the written descrip-	tion doctrine, it noted: "The purpose of the	an applicant from later asserting that he in-	s patent is therefore required 'to recount his	invention in such detail that his fature claims	his original, creation. " Angen Inc. v. Ho-	that Marion Kouser Inc., 314 F.3d 1313, 130, 65 USPO2d 1385, 1397 (Fed. Cir.	2000) (citing Na-Cath Inc. v. Maharkar, 935	ed Cir. 1991)). In that setting, the written	description is the metric against which a sub- secuently added claim is measured to deter-	refree if it is due the priority date of the origi-	these singions is most often pursed as	whether the application provides 'adequate numers' for the claim(s) at issue: it has also	been enalyzed in terms of 'new matter' under	35 U.S.C. § U.Z."); In nr Wright, 869 F.Zd 472, 424, 9 USPO2d 1649, 1651 (Fed. Cir.	1989) ("When the scope of a claim has been	unify an assertion that it is directed to a dif-	a proper to inquire whether the newty	patient application when filed as the invention of the amplicant. That is the exerces of the so-

438 Month of the Control of the Cont	Moba S.V. v. Diemond Automation Inc.	mir.	to User con	standal record evidence. Therefore, the trial
	called 'description requirement' of § 112, first	P.W.	uponal descriptions on general money the	count correctly determined that claim 24 is not
_	paragraph."). In General Golfors, the natentee described in	es d	writen description requirement; rather, the	givalio for man or as annual control or as annual c
	the specification a sectional soft with a center	epi 8	requirement may be satisfied it in use	
-	comole including rectiner cootrols. The speci-	e es	to sufficiently correlated to a particular.	D. D. Startbern in
	as the only possible location for the controls.	PECOE	known structure.	The parent specification must care solited in
and posteration, as of the medific subject mai-	rom the specification, it was clear that the	are.	Amgen, 314 F3d at 1332	the art to make and use the claimed invention.
er later claimed by him." In as Werthelm, 541	patentee considered placement of the controls	NA.	[5] The test for compliance with § 114 fits	35 U.S.C. § 112 § 1. That some experimenta-
F24 257, 262, 191 USPQ 90, 96 (CCPA	to the center consule to the consultant control of his lovention." Gently Goldery, 134	,	always required supported and the investor	tion is required to practice use catalogue.
976). Although the statute proscribes addi-	P.3d at 1479. Hence, this court limited the	- Are	morrescent the invention at the time of the	Adar Pander Co. N. E.L. DuPont De Nemours
tion of new matter to a specification or claims	scope of the patentee's claims to a sofa with	Par	original filing. See Var-Cath, 935 F.2d at 1561	4 Co. 750 F.24 1569, 1576, 224 USPQ 409.
moer 9 134, the Office States Come of Con-	controls located in a center console: Accord-	, un	("Adequate description of the invention	413 (Fed. Clr. 1984). Enablement under 30
addition of new matter to claims separately	ngly, two parences, unputs describe	li es	guards against the tovernor a prescribed in such	U.S.C. § 112, § 1, is a question of any una
using \$ 112. In re Rasmussen, 650 P.2d 1212.	tere-drafted claims. Id. at 147 (emphasis	154	detail that his future claims can be determined	Corn. v. C8S, Inc., 793 F.2d 1261, 1268, 229
211 USPQ 323, 325-26 (CCPA 1981).	edded). Thus, because Geniry Gallery applied		to be encompassed within his original ore-	USPQ 805. 810 (Fed. Clr. 1986). This court
1 has court a presence of the symmetry because	112, ¶ 1, to hold the patentee to use scope of		ation"). The possession test requires assess	reviews a jury's underlying factual decenturies
a rejection of an amended claim under § 132	where PPS made no allegation at all that the	rece	ment from the viewpoint or one or and	tions related to conditions to Ampea Corp.
s equivalent to a rejection under § 112, first	disclosure of the '505 patent did not show pos-	ritt	convey with reasonable clarity to those skilled	190 F3d 1300, 1309, 51 USPQ2d 1910, 1916
paragraph." Id. Since then, this court has con-	session of a later-filed claim.		in the art that, as of the fifting date sought, be	(Ped. Clr. 1999).
inued to use § 112 to ensure that a patentice	The second application of the written de-	n) q	or she was in possession of the treeslion	[6] FPS contends that the specification does
had possession at the time of ning or augment	scription requirement is reneaded in Agency of		(emphasis in original); Union Oil Co. 9)	not enable one of ordinary skill in the art of
most meent application of the written descrip-	119 P.3d 1559, 43 USPQ2d 1398 (Fed. Cir.		CA LICENSTA 1227, 1232 (Fed. Cir. 2000)	ult eggs from a morale Court of the
tion doctrine, it noted: "The purpose of the	1997). There, this court invoked the written	in	("The written description requirement foes	
written description requirement is to prevent	description requirement in a case without pir-	or to	not require the applicant to occurs execut	amount of experimentation due of state in the
vented that which he did not; the applicant for	precise definition of a DNA sequence in the	Wa	scrintoo must clearly allow persons of ordi-	ing system of the Moba Omnia in view of the
a patent is therefore required to recount his	patent specification. In more recent cases,	24	nary skill in the art to recognize that the or	
invention to such detail that his future claims	flowever, this court has managaismus and	4	the) invented what is common of the	
can be determined to be drompossed within	Probe, Inc., 296 F.3d 1316, 63 USPQ2d 1609		showed that the specification that taught one	
echt Marion Roused Inc., 314 F.3d 1313,	(Fed. Ch. 2002), neither the specification for		of shill in the art to make and use an inven-	
3, 65 USPQ24 1385, 1397 (Fed. Cir.	the deposited thological material ported the		tico also convinced that ground that the con-	
3) (citing Yur-Carls Inc. v. Mahuman, 935	or physical properties, required by Lilly, Id. at		tor possessed the livestonic cule does not require	
1 1535, 1561, 19 Cor (an 1111, 1115)	1324 (quoting Lilly, 119 F3d at 1566). Al-		a carticular form of disclosure because one of	
description is the metric senting which a sub-	though this court initially determined that the	-	skill could determine from the speculosition	
sequently added claim is measured to deter-	specification in Euro and not assist un carry	100	that the investion possessed use to consent the state of filing	
mine if it is due the priority date of the origi-	manded to the district court. The court in-		Accordingly, substantial evidence supports	
parent, id. at 1500 ("The question resident	throttd:		the jury's farding that the 505 pareot is not in	
whether the application provides 'adequate	On remand the court should determine		valid for lack of an adequate written describes	8
support' for the claim(s) at issue; it has also	whether a person of stell to the set would		uon. The 300 patent appearance of the sufficient detail	
been analyzed to terms of 'new matter' upder	gless from the written description, the descrip-		to that one of ordinary still in the art would	
35 U.S.C. § 132. J. In R. William, 800 Feb.	in of the claimed penuences, subsequences,	1	recognize that the inventor pessessed the in-	
1989) ("When the scope of a claim has been	musted varietts and mixtures sufficient to		vention at the time of things of adopted dis-	-
aged by amendment in such a way as to	demonstrate possession of the generic		close lifting eggs from a moving conveyor	
parity as assertion that It is directed to a dire-	scope of the casma.		menty revives in non-infragement arguing	
proper to inquire whether the newly	Serie, 296 F.3d at 1528. Similarly, in this		the close of walled one of skill to the ext	.m
claimed subject matter was described in the	More presently in Farro Biochem, we clari-		would discern possession of the invention at	
patent application when nice as me invalidue.	feed ther PII Lilly did not hold that all func-	1	the time of filing, a finding supported of the	
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A CHILD CONTROLL OF THE PROPERTY OF THE PROPER			
· · · · · · · · · · · · · · · · · · ·	o assertant and	- B H B B H H G B B H H H B B H B B H B H	within descriptor of control. The well-the- per decision, spills of it was be subsequently as the modified within the most was the beautiful of the modified interface. Life, 10 Total or the modified interface of the modified in the modified in the modified in the modified in the modified modified in the modified in the modified in the modified in the modified in the modified in the modified in the modified in the modified in the modified in the modified in the modified in the modified in the modified in the modified in the modified in the modified in the modified in the modified in the modified in modified in the modified in the modified in the modified in modified in the modifie
and the second s	more som	and seems a seems and a seems and seems of the seems of t	(Pet. C. 2000) and the size with charges and a popular size with charges and a repetation to the size with charges and a repetation to the size with charges and a size with charges and a size with charges and a size with charge a
	Automation Inc. 66 USPQ2d	see as we require worms assisting to the control of	we to receive "pression of the control of the contr
A consequence of the CPGTQ and a control of the	Moba B.V. v. Diamond Automation Inc.		The answers at date in calculated and interest cases the part of the case and the c

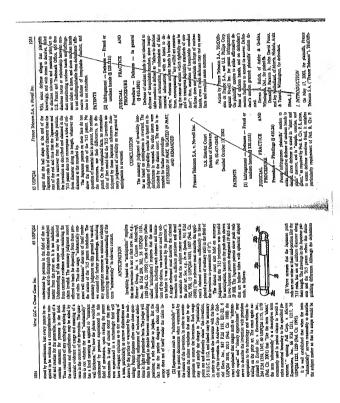
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is to thew possession, and to show possession	The sections of the section of the s	W	in sum, the Luly rule is not just a user con-	case law. It finds no specific support in any	stantory language, it creates a community	specific fulls in a terminology toward and declarate decourts the statute's rules for adequate disclo-	sure of inventions. It complicates blotechnol-	ogy patent drafting to the point of near impos-	sibility and invites invalidating mutates. Il	prices non-corporate inventors out of some	not least it burdens both trial and appellate	courts with unaccessary and confusing proce-	dures in otherwise simple cases like this one.	Of course, this court should recognize and	prevent, refrest train ignores and creek, in	the ram event that this court makes this type	of error, this Circuit has a unique obligation to	swiftly pursue on bane correction. Unlike To-	gional circuits, and count cannot be you	Court correction. Moreover this court's junis-	diction over patents requires every trial court	and this court itself to mainpy our type of co-	a greater responsibility to pursue en bane cor-	rection of serious errors in interpretations of	the Patent Act, such as the Lany tune.	son's concurring opinion, the problem in this	area of the law may lie in the line of cases	stemming from the Alexand Concession of the	more than adequately resolved under the new	matter doctrine in 35 U.S.C. § 132.	Breson I concurring	Having been a member of the panel that de-	cided Regents of the University of Catifornia	1393 (Ped. Cir. 1997), I write to make a nogle	point with regard to the count's decision in		Parent scholan have excented that court to re-	and referred (that countries towards referring the countries	men concept, particularly as it contries to claim		-		man like in the count, heateney to explore the power
	have the unintended consequence of pricing and pro-	market for biotechnology.	1									cleatly contained to purchase 1332, 1361					is find when "one of skill in the arr would use		distinguish the so-called written description	requirement from enablement. In reversing its	original decision that deposits of provinces	requirement, the Ento panel cited cases that	found that such deposits satisfy the enable-	ment requirement. In ourse words,	and Faro panel, the court on reconsideration	had to concede that deposited material sales	fies the Lilly standard if it meets use control	With some understanding of the difficulties	and redundancy of the Lilly rule, the Pederal	Circuit has begun to convert it into the challe-	ment godding wan a maccon the fix that the	trial court faced in this case - presenting the	jury two disclosure documes with appearing	and the second	"See East, 196 F.M at 1325 ("Whether reformed to	a deposit of a madestide sequence may adequately de-	to come in livin of the Matery of bisingful deposits	for parest purposes lend) the parits of parest law we	beld that reference in the specialistic to a upper me	tion of the deposited material . The practice of depos-	little bloighed marchal areas printerly to settly the	Parallels. 49 F.24 1350, 168 USPQ 59, 100 (CCPA	(970) (Chaling that market the biological relation
-	100	40	1020	Cro's	742	NO.	ris r	N. P.	e ș	ire.	999	4	di.	100	462	177	7	14			*	70	GIA.	-	24		ist.	80				1		100	90	To the					松		1
mercenned to ented from the advent of the biotech entit the		rule in 1997, no diventor could have toteled	_	issued patents to accommodate the new rule, a	_	_			a drafter beyond reasonable imits. A new pro-		-		the functional properties of the protein. Con-			_			This burdensome disclosure standard is tan-	. 25		symbol by symbol, including all source con-			software inventions, but apparently enforces,			t consulty disting that a puten on the an-	-	aspect of the Lilly doctrine. That is, it imposes		_	the Littly rule imposes technology-specific to-		2	_	strily increase the cost and time required to		_		under the Lilly rule. Sequencing is very ex-	٠.	A C. Dit Life 110 E'M at 1666 (relies the "needite
1942 mood of court manned to	create another doctrine for sufficiency of dis-	closure. Although characterized as a written	the state of the origin to the state of to say	prior case. See generally Ento, 63 USPQ2d at	1627-29	Confusing the Lilly disclosure doctune with	the transport writer description description is	separate from enablement. See Ampen, Inc. 14	Hoeckst Marion Roussel, Inc., 314 F.3d 1313,	65 USPQ2d 1385 (Fed. Car. 2003). Of course,	this proposition is true with respect to use the	hine On the other hand the only way to dis-	tinguish the Lilly rule from enablement is to	consume Lilly as requiring more disclosure	than recessary to enable one of skill in the art	to make and use the invention, a super-	those terms however present tayen code-	guences for biosechnology. For biotechnologi-	cal inventions, Lilly purports to require the	recitation, ourcleotide by nucleotide, of the en-	This non-trautory rule jeoperdizes the valid-	ity of many inventions to biotechnology pat-		*U.S. Parest No. 4,052,323, at uses in Ling.	The art of biotechnology was in its carty stages in	1977. Under a proper emblement analysis, the surple declosers of benne health cDNA in the 325 patent	would have failed to enable a person abilied in the act	is 1977 to peaches the datased saveston. 1923, the	of cashinness.	"See Rad, And, "justification Property Region in 100- inchmolern: Addressing New Technology" 34 Works	Force L. Rev. \$27, \$34-35 (Fall 1999) ("the Lift)	of deviced customers requirement "); Sampson, Man-	gare, "The Brokulon of the Euchtenant and William Commission Descriptors on Judge 35 Jl 5C & 112 in the	Area of Biotechnology" 15 Sertity Tech. LJ. 1233	(262 (Full 2000) ("The primary enguisers supplied the	quirment for bistochoological invention is that it	also bretaers in party to parent in instruction by do	priving potential parenters of the opportunity to fairly	"The Evelving Application of the Writtes Description	Regularment to Biotechnological tavestions" 13 flor-	caion enablishes unquely rigorous rules for the de-	scription of biotechnological subject matter that signifi-	Company of the Compan

Ion - Specification	In Benefits	Patent construction — Claims — Broad or narrow (§ 125.1303)	Claims of patents for computerized switch- og systems are not limited to sole embodi-	ment disclosed in written description, since record shows that there has been no "admis-	sion" by infingement plaintiff that particular embodiment constitutes entire invention, and	since written description cootains no words or exmessions of manifest exclusion or restric-	tion, representing clear disavovral of claim		Particular patents — Electrical — Com- puterized switching systems	Bearley, Seifert, Lacrampe,	Huffington, Greene, and Hafer, interconnec-	tion system for viewing and connected computers with on-screen	video overlay for controlling of the micron- portion twitch, infament of noninfringement	A. St. of London	\$937,176, Beaney, Schief, Leatening, pffington, Greene, and Hafer, interconnec-	tion system having eircuits to packeuze sevoord/mouse electronic signals from plural	worklasses and supply to keyboard/mouse	crosspoint switch, judgment of noolnifringe-	Beasley, Seifert, Learnings,	Huffington, Greene, and Hafer, computer the	for remote codyrol of the interconnection		: الم	Appeal from the U.S. District Court for the Confirm District of New York, Pollack, S.J.	Action by Apex Inc. against Ranten Com-	puter loc. for paters infringelyees. Plantill ep-	18	James D. Berquist, J. Scott Dayddson, and December J. Jackson, of Nixon & Vanderbye,	Jaintiff-uppellant	Mr. Hill, of Ward & Olive, New York, N.Y.	le.
bearing to the Co.	(6) Patent construction and drawings - (§ 125,1101)	Patent construction — Cl or narrow (§ 125.1303)	Chaims of patents for iog systems are not it	ment disclosed in wr record shows that then	sion" by infingement embodiment constitute	since written descripto	tion, representing cle	-do-	Particular patents — Electrica puterized switching systems	5.884,096, Bearle	Huffington, Greene,	motely connected co	video overlay for cor	vacated	Huffington, Greene,	tion system having heveoard/mouse elect	workship and su	crosspout switch, J	6,112,264 Bensi	Huffington, Greene,	for remote control			-					٤ ٢	Z	
1000	sylvems, does not require capability of locked- ing lock keyboard and mouse signals, since ordinaty meaning of "data packet" is "s unit	of inferhation transmitted as a whole mounting the device, is another on a network," since nothing in written description suggests that	keyboard signal must accompany mouse sig-	evince need to depart from ordinary meaning	data packet" is properly construed to mean	one device to another on network that in-	Calms -	25(300)	Patent construction - Claims - Della-	Truns "overlay" and "overlaid when sig-	sals," as used to claims of putents for comput-	inted switching systems, or too interest at	same spot on motitor at same time, since	require such display, aince definition of "over-	ing in context of companies was the singer,	since writen description supports una utur- nary meaning by providing numerous meth-	ods for displaying "overlaid" images in ac-	tion history, he form of preliminary amend-	limit ordinary meaning of "overlay" or		[3] Patent construction — Claims — Broad or narrow (6.125.1303)	Potent construction - Claims - Defin-	Ing terms (§ 125.1305)	Term "switch," as used in claims or parents for computationd switching systems, is not	limited to device that opens or closes circuit	o form direct pain between topous any our	dialay meaning of "switch" is "a device Ca-	public of forwarding purchase menty of ports account and purchase metwork ad-	drasses, "ince written description goes ool	circuit to form direct path, and since nothing	in protection towns a series of
5 <u>I</u>	TE 8			. Б	o de la		comment.	mat T	-	NO.	-	are;	Care II	in the	no stell	denç	-		tions.		oning.		100	100	瓣			137			
Apex Inc. w Rartion Computer Inc. 60 Ost 420	of cases is based on a fundamentally flewed construction of 33 U.S.C. § 112, paragraph 1.	Apex Inc. v. Raritan Computer Inc.		Federal Circuit	8	PATHENTS	[1] Patent construction Claims	ď.		function limitations, exted by relying on single			graph, does not apply, since ordinary meaning				qualification, such as "interface," program-		2		8				• 33			en (3) Patent construction - Claims -	å		g. Term "serial data packet," as used in
5	that case. Lifty has been criticized as depart- ing from price law by applying the written de- notation consistents for a mineste other than	to police priority. Setting aside the question whether the disclosure requirement imposed	in Lilly was unduly stringed, a point una fudge Rader addresses to his concurring opin-	ion, I do not believe that Lufy constituted a departure from prior law when it applied the	written description requirement in a non- priority context.	In re Ruschig, 379 P2d 990, 154 USPQ 118 CCPA 1967), held that 35 U.S.C. § 112, pare-	graph 1, contains a written description re- mirement that is generate from the enable-	ment requirement found in the same para-	or may not have been correct.—there is some-	of statutory construction. But there is no ques-	tion that Reachly and subsequent decisions have held that written description and enable-	ment are separate statutory requirements, and	emblement. Judge Rader acknowledges as	enuch, but argues that as long as the funching doctrine was confined to cases involving pri-	onty disputes, that reading of the statutory	was simply redundant of the statutory prehib-	tion against flow matter in 35 U.S.C. § 132. The problem, as I see it, is that if it is correct	to read section 112 as containing a separate written description requirement, it is difficult	to find a principled basis for restricting that re-	facre is no language in section 112 that	around support such a restriction, and 1 and un- twace of any other busis for constraing the	nature in that factores, unless we are unitary to unnounce that the <i>Ruschig</i> cases will be toler-	ated, but must be limited to their facts. Put so-	cound as a matter of statutory construction, it	a difficult to see why that construction uses so apply equally in the Lilly non-pefority onn-		Perhaps the entire line of cases stemming,	though at some point address that question on	uncture. I think it is worth pointing out, how-	ever, that the real question raised by Judge Rader's stantiony analysis is not whether Lilly	was an unwarranted departure from the Rus-

2. Verve v. Crane Cam Inc., 64 USPQ2d 1051 Fed Cir. 2002), pages 70-72

Antonical Incidency In a Distriction of the Board of the Art Principal Antonical Incidency and the Board of the Art Principal Antonical Incidency and the Art Principal Antonical Antonica	65 USPQ2d YEAR LLC Y'CM	The state of the commons of policy in a second control of the cont	ion M.P.B.P. § 609, which, at the time of Plant- tiff's application for the '662 patent, fused as follows:		parent application when examining a con-	mation need not be submitted in the con-	the Information to be printed on the patter.	MREP § 609 (Rev. 3, July 1977). The court	not be inequitable conduct for an applicant not	information that was cited of submitted in the	in the state of th	[1] While the issue ATD concerned a divi-	stonal application rather than a continuation					foods that there igno basis for inseparators con- duct in Plaintiff's faithre to cite the Gross and DE	Court of Leaven, 47 F34 953,957 (8th Zaduka references to the '662 Pateri. Plaintiff Motion for Partial Summary Court of Leaven, 47 F34 953,957 (8th Sec. No. 731) is GRANTED.	3. Other Alleged Inequitable Conduct	Inequitable conduct by a patrat applicant	see from the property of the p		1938) (ch banc), cen. demied, 490 U.S. 1067	(1989), The Federal Chronit has set out a test Decided	The primary focus of Plaintiff's motion for "Well on partie have not briefed the have digital PATENTS		M.P.E.P. 4 609, State Ed. Ren. 1 (September 1993). M. 242 A. 600 Flotts Ed. (Annual 2001). However, R.	appears to the Count that the various Mandred versions		
	Mounced Respiratory Inc. × Electromed Inc.	Based upon these asserts that Plaintiff mary Judgment to e uitable conduct defi	ď	1. Standard of Review Summary judgment is	disputed lasues of it	law. Fed. R. Civ.	may be reasonably	party. Exterprise Ba	over, no H3d-743,	"[s]ummary judge	cut, but rather as a	eral Belies as a who secure the just, soo	mination of every	Estorer Corp. v. C (1986).	The moving pa	terial fact and that	a matter of law. E	the existence of s	x County of LeSu	Cir. 1995). A party ported motion for a	rest upon mere alle	set forth specific for	Lobby, Inc., 477 U	*/ F-10 III 95/.	2. The Gross and	The primary for	dunt's claim that if	ences were improp	Federal Circuit's d	dell, Inc., is disp	In ATD, the Federal Circuit Court of Ap-

4 UP TERESPORE WE AND 0 5 DEFORE OF THE	when the Lit & Cont of the Guideline and the state of the	the one would, asker pass not as "lives on many and a "lives on many," and "lives on "	and all the lower generation of content and only the lower generation of the lower and the lower generation of the lower and the preceding the lower generation of the lower and the lower generation of the lower and the lower generation of the low	the second of the property of the second of
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X. RELATED PROCEEDINGS APPENDIX

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